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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,024	03/12/2002	Kimihiro Yoshizako	PL-9937	4573

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AMERSHAM BIOSCIENCES
PATENT DEPARTMENT
800 CENTENNIAL AVENUE
PISCATAWAY, NJ 08855

EXAMINER

THERKORN, ERNEST G

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 07/14/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/018,024

Applicant(s)

YOSHI ZAKO

Examiner

THERKORN

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on June 19, 2003
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-11 is/are pending in the application.
- 4a) Of the above, claim(s) 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 10-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 840 6) ☐ Other: _____

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Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. "(P)ackaging" is considered to render the claim indefinite.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7 and 10-11 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of copending Application No. 09/532,285. Although the conflicting claims are not identical, they are not patentably distinct from each other because they differ only in an obvious difference in scope.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 and 10-11 are rejected under 35 U.S.C. 102(B) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over each of JP 09-049830 including the MAT translation of JP 09-049830, JP 08-103653 including the PTO translation of JP 08-103653, JP 07-136505 including the PTO translation of JP 07-136505, and JP 07-135957 including the PTO translation of JP 07-135957. The claims are considered to read on each of JP 09-049830 including the MAT translation of JP 09-049830, JP 08-103653 including the PTO translation of JP 08-103653, JP 07-136505 including the PTO translation of JP 07-136505, and JP 07-135957 including the PTO translation of JP 07-135957. However, if a difference exists between the claims and each of JP 09-049830 including the MAT translation of JP 09-049830, JP 08-103653 including the PTO translation of JP 08-103653, JP 07-136505 including the PTO translation of JP 07-136505, and JP 07-135957 including the PTO translation of JP 07-135957.

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07-136505, and JP 07-135957 including the PTO translation of JP 07-135957, it would reside in optimizing the elements of each of JP 09-049830 including the MAT translation of JP 09-049830, JP 08-103653 including the PTO translation of JP 08-103653, JP 07-136505 including the PTO translation of JP 07-136505, and JP 07-135957 including the PTO translation of JP 07-135957. It would have been obvious to optimize the elements of each of JP 09-049830 including the MAT translation of JP 09-049830, JP 08-103653 including the PTO translation of JP 08-103653, JP 07-136505 including the PTO translation of JP 07-136505, and JP 07-135957 including the PTO translation of JP 07-135957 to enhance separation.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over each of JP 09-049830 including the MAT translation of JP 09-049830, JP 08-103653 including the PTO translation of JP 08-103653, JP 07-136505 including the PTO translation of JP 07-136505, and JP 07-135957 including the PTO translation of JP 07-135957 in view of Mikes' Laboratory Handbook of Chromatographic and Allied Methods 1979, pages 388-390. At best, the claim differs from each of JP 09-049830 including the MAT translation of JP 09-049830, JP 08-103653 including the PTO translation of JP 08-103653, JP 07-136505 including the PTO translation of JP 07-136505, and JP 07-135957 including the PTO translation of JP 07-135957 in reciting use a spacer. Mikes' Laboratory Handbook of Chromatographic and Allied Methods 1979, pages 388-390 discloses that a spacer makes a ligand more accessible to its target substance. It would have been obvious to use a spacer in each of JP 09-049830 including the MAT translation of JP 09-049830, JP 08-103653 including the PTO translation of JP 08-103653,

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JP 07-136505 including the PTO translation of JP 07-136505, and JP 07-135957 including the PTO translation of JP 07-135957 because Mikes' Laboratory Handbook of Chromatographic and Allied Methods 1979, pages 388-390 discloses that a spacer makes a ligand more accessible to its target substance.

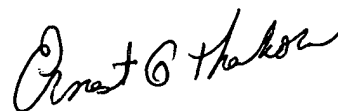
Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over each of JP 09-049830 including the MAT translation of JP 09-049830, JP 08-103653 including the PTO translation of JP 08-103653, JP 07-136505 including the PTO translation of JP 07-136505, and JP 07-135957 including the PTO translation of JP 07-135957 in view of each of JP 08-103653 including the PTO translation of JP 08-103653 and JP 09-049830 including the MAT translation of JP 09-049830 and Hosoya (Anal. Chem. 1995,67, 1907-1922). At best, the claim differs from each of JP 09-049830 including the MAT translation of JP 09-049830, JP 08-103653 including the PTO translation of JP 08-103653, JP 07-136505 including the PTO translation of JP 07-136505, and JP 07-135957 including the PTO translation of JP 07-135957 in reciting use of epoxy and use of uniformly sized particles. Each of JP 08-103653 including the PTO translation of JP 08-103653 (page 9, lines 7-10) and JP 09-049830 including the MAT translation of JP 09-049830 (page 15, lines 1-9) discloses epoxy allows connection of the ligand. Hosoya (Anal. Chem. 1995,67, 1907-1922) (Abstract) discloses that uniformly sized polymer based packing materials separate faster with better resolution. It would have been obvious to use epoxy and uniformly size particles in each of JP 09-049830 including the MAT translation of JP 09-049830, JP 08-103653 including the PTO translation of JP 08-103653, JP 07-136505 including the PTO

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translation of JP 07-136505, and JP 07-135957 including the PTO translation of JP 07-135957 because each of JP 08-103653 including the PTO translation of JP 08-103653 (page 9, lines 7-10) and JP 09-049830 including the MAT translation of JP 09-049830 (page 15, lines 1-9) discloses epoxy allows connection of the ligand and Hosoya (Anal. Chem. 1995,67, 1907-1922) (Abstract) discloses that uniformly sized polymer based packing materials separate faster with better resolution.

The restriction and elections of species have been reconsidered, deemed proper, and made final for the reasons of record.

Any inquiry concerning this communication should be directed to E. Therkorn at telephone number (703) 308-0362.



Ernest G. Therkorn
Primary Examiner
Art Unit 1723

EGT/12
July 9, 2003